REMARKS

The issues outstanding in this office action are:

- Claims 1-10, 13, 14, and 18 are rejected under 35 U.S.C. § 103.
- Claims 11, 12, 16, 19, and 20 are allowed.

Based on the remarks contained herein, Applicants respectfully traverse the outstanding rejections.

Rejection under 35 U.S.C. § 103(a).

Claims 1-10, 13, 14, and 18 are rejected under 35 U.S.C. § 103(a) as being patentable over Earnest et al., of record, in view of the newly cited Drake (U.S. Patent No. 2,049,764). To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criterion, Applicants assert that the first and third criteria of the prima facie case of obviousness are not satisfied.

Claim 1 defines the limitations "protective material on the low frequency eddy current probe" and "the protective material abutting the rail head when the transporter moves on the railway track thereby protecting the low frequency eddy current probe from damage." Drake does not teach or suggest the use of a protective material or having this material abut the rail head and is no more pertinent to the limitations of Applicants' claims than is the previously-cited Wilson.

As with the Wilson reference applied in the preceding office action, Drake teaches "maintaining the axis of the coils at all times at a fixed distance above the rail surface." See Drake, col. 2, lines 26 – 28. Moreover, this "distance" in Drake is occupied by a combination of an air space, the housing 21, and a sled 39 (or roller) as shown in Figure 2 of Drake. There is no teaching or suggestion of providing a protective material on the coils or sensor of Drake. There is, moreover, no motivation to modify the Drake system to provide such protective material since the coils of Drake are not in contact with the rail and do not incur a risk of damage from such contact.

Accordingly, the applied art does not teach or suggest all the limitations of claim 1, and claim 1 is patentable over the proffered combination of Earnest et al. and Drake. Claims 2-10, 13, and 14 depend from claim 1, inherit all the limitations thereof, and are therefore patentable over claim 1 for the same reasons as claim 1. Moreover, the dependent claims recite further novel, nonobvious limitations not taught or suggested in the prior art. Accordingly, claims 1-10, 13, and 14 are patentable over Earnest et al. in view of Drake under 35 U.S.C. § 103(a).

Claim 18 defines the limitation "applying a force to the low frequency eddy current probe against the rail head as the transporter moves on the rail". Drake does not teach this limitation. In Drake, instead of being upon the rail head, housings containing the sensing coils are "on sleds 39, or upon rollers . . . ." The applied art, therefore, does not teach or suggest all the limitations of claim 18, and the prima facie case of obviousness is therefore not satisfied for claim 18 under M.P.E.P. § 2143. Accordingly, claim 18 is patentable over Earnest et al. in view of Drake under 35 U.S.C. § 103(a).

Conclusion:

The Examiner is thanked for the allowance of claims 11, 12, 16, 19, and 20. In view of the remarks contained herein, Applicants contend that all claims are allowable and respectfully request that the instant application be passed to issue. Should you have any questions regarding the above, please feel free to give the below-listed attorney a call. If additional fees are required, please debit our Deposit Account No. 04-1414.

Respectfully submitted,

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